UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,516	10/02/2003	Wataru Shinozaki	03600/LH	1969

1933   7590   08/26/2008
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER
CAO, PHUONG THAO

ART UNIT	PAPER NUMBER
2164	

MAIL DATE	DELIVERY MODE
08/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
	10/678,516	SHINOZAKI, WATARU
Office Action Summary	Examiner	Art Unit	
	Phuong-Thao Cao	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>12 June 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-7</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-7</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
       1.☐ Certified copies of the priority documents have been received.
       2.☐ Certified copies of the priority documents have been received in Application No. _____.
       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>06/12 and 08/06/2008</u>.
4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____
5)☐ Notice of Informal Patent Application
6)☐ Other: _____

DETAILED ACTION

1.   This action is in response to Amendment filed on 06/03/2008 and entered with an RCE

filed on 06/12/2008.

2.   Claims 1, 2, 4, 6 and 7 have been amended. Currently, claims 1-7 are pending.

Continued Examination Under 37 CFR 1.114

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 06/03/2008 has been entered.

Information Disclosure Statement

4.   The Information Disclosure Statements (IDS) filed by Applicant on 06/12/2008 and

08/06/2008 have been received and considered. Copies of the reviewed IDS(s) are enclosed with

this office letter.

Response to Arguments

5.   Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

6.   Claim 6 is objected to because of the following informalities: typo "clams" (line 1) should be "claim". Appropriate correction is required.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

     Regarding claims 1-3, 5 and 6, these claims are for a system (i.e., apparatus). However, all of the elements claimed could be reasonably interpreted in light of the disclosure by an ordinary artisan as being software alone, and thus is directed to software *per se*, which is non-statutory.

          In order for such a software claim to be statutory, it must be claimed in combination with

an appropriate medium and/or hardware to establish a statutory category of invention and enable

any functionality to be realized.

                              Claim Rejections - 35 USC § 102

9.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

          A person shall be entitled to a patent unless –

          (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
          in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
          patent by another filed in the United States before the invention by the applicant for patent, except that an
          international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
          subsection of an application filed in the United States only if the international application designated the United
          States and was published under Article 21(2) of such treaty in the English language.

10.   Claims 1 and 4-7 (effective filing date 10/09/2002) are rejected under 35 U.S.C. 102(e) as

being anticipated by Takemoto (US Patent No 6,335,742 , effective filing date July 24,1998).

          As to claim 1, Takemoto teaches:

          "A data editing apparatus" (see Takemoto, Abstract and [column 12, lines 25-65])

comprising:

          "a storage section" (see Takemoto, [column 5, lines 32-34] for memory), including:

          "a first folder to store audio data and image data that is linked to a playback position of

the audio data and a second folder to store only image data and no audio data";" (see Takemoto,

[column 8, lines 55-57] and Fig. 9 for a system including a plurality of folders wherein one of the

folders can include both audio data and image data (see Fig. 4, for folder 'tmp' including both

image files and their corresponding audio files linked/associated with them) and wherein one of

the folders can include only image data (see [column 10, lines 45-50] for folder to register/store

image data)).

"link release means for canceling the link between the audio data and the image data

linked therewith which are stored in the first folder" (see Takemoto, [column 7, lines 46-49] for

function to disassociate sound (audio data) from image file (image data), also see [column 12,

lines 55-60]).

"moving means for moving the image data, from which the link is canceled from the first

storage area to the second storage area when the link is canceled by the link release means, such

that the image data from which the link is canceled is no longer stored in the first storage area"

(see Takemoto, [column 9, lines 15-18] for function of moving an image file from one folder to

another folder; also see [column 7, lines 35-65]).

As to claim 4, Takemoto teaches:

"A computer-readable storage medium having a data editing program stored thereon

which is executable by a computer to cause the computer to edit audio data and image data

linked to a playback position of the audio data" (see Takemoto, Abstract and [column 12, lines

25-65]), "wherein the audio data and the image data linked thereto are stored in a first folder"

(see Takemoto, Fig. 4, for folder 'tmp' including both image files and their corresponding audio

files linked/associated with them), and "a second storage area wherein only image data, and no

audio data, is stored in the second folder" (see <u>Takemoto</u>, [column 10, lines 45-50] for folder to

register/store image data).

"canceling the link between the audio data and the corresponding image data stored in the

first folder" (see <u>Takemoto</u>, [column 7, lines 46-49] for function to disassociate sound (audio

data) from image file (image data), also see [column 12, lines 55-60]).

"moving the image data, from which the link is canceled from the first folder to a second

folder in the memory of the computer when the link is canceled by the link release means, such

that the image data from which the link is canceled is no longer stored in the first storage area"

(see <u>Takemoto</u>, [column 9, lines 15-18] for function of moving an image file from one folder to

another folder; also see [column 7, lines 35-65]).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 1

and is similarly rejected including the following:

<u>Takemoto</u> teaches:

"audio data selecting means for selecting a target audio data to be subjected to link

addition in an audio data list display area" (see <u>Takemoto</u>, [column 12, lines 55-62 wherein

entering a sound file name serves as a way to select an audio file in the system);

"means for selecting image data to be linked with the selected audio data from among the

image data stored in the second folder" (see <u>Takemoto</u>, [column 14, lines 15-20] for browsing

files including image files);

"means for linking the selected audio data with the selected image data and copying the

linked selected audio data and selected image data to the first folder" (see Takemoto, [column

12, lines 55-63] for setting sound with image data and see [column 7, lines 53-55] for function to

copy files; also see [column 8, lines 55-60);

"means for, after the copying of the linked selected audio data and selected image data to

the first folder, deleting the selected image data from the second folder" (see Takemoto, [column

7, lines 50-52] for deleting any selected files).

On the other hand, Nozaki et al. teach:

"means for linking the selected audio data with the selected image data and copying the

linked selected audio data and selected image data to the first folder" (see Nozaki et al., Abstract

and [0082] for linking and copying audio data and image data in the synthesizer).

As to claim 6, this claim is rejected based on arguments given above for rejected claim 1

and is similarly rejected including the following:

Takemoto teaches:

"display means for displaying an editing window that includes a first display area for

displaying a list of audio data stored in the first storage area such that the audio data is selectable,

a second display area for displaying a list of image data stored in the second storage area, and a

third display area for displaying a list of image data that is linked to audio data that has been

selected from the list of audio data displayed in the first area" (see Takemoto, [column 14, lines

15-20] and Fig. 9 for an editing window including list of images with or without associated

sounds (see Fig. 11) wherein an individual can be interpreted as a list of one); and

"wherein the link release means cancels the link between the audio data and image data linked therewith which are stored in the first folder, in response to an operation on the editing window" (see <u>Takemoto</u>, Fig 6 and [column 7, lines 45-50]).

As to claim 7, <u>Takemoto</u> teaches:

"A computer-readable storage medium having a data editing program stored thereon which is executable by a computer to cause the computer to edit audio data and image data linked to a predetermined playback position of the audio data, the program being executable by the computer to cause the computer to execute functions" (see <u>Takemoto</u>, Abstract and [column 12, lines 25-65]) comprising:

"displaying on a display of the computer an editing window that includes" (see <u>Takemoto</u>, Fig. 9):

"a first display area for displaying a list of audio data that is stored in a first storage area in a memory of the computer, such that the audio data is selectable" (see <u>Takemoto</u>, Fig. 11 for 'sound setting existence' display area which is associated with an audio file wherein an audio file can be interpreted as list of audio data (i.e., list of one file)),

"a second display area for displaying a list of image data that is not linked to audio data being stored in a second folder in the memory that is different from the first folder" (see <u>Takemoto</u>, Fig. 9 wherein the folder display area 400 allows user to display a list of files in any folder), and

"a third display area for displaying a list of image data that is linked to audio data that has been selected from the list of audio data displayed in the first display area, the image data that is

linked to the audio data being stored in the first folder" (see <u>Takemoto</u>, Fig. 11 for 'file name'

display area which is associated with an image file wherein that file name can be interpreted as

list of audio data (i.e., list of one file))

"canceling a link between the audio data and the corresponding image data stored in the

first folder, in response to an operation on the editing window" (see <u>Takemoto</u>, [column 7, lines

46-49] for function to disassociate sound (audio data) from image file (image data), also see

[column 12, lines 55-60]).

"moving the image data, from which the link is canceled from the first storage area to a

second storage area when the link is canceled by the link release means, such that the image data

from which the link is canceled is no longer stored in the first storage area" (see <u>Takemoto</u>,

[column 9, lines 15-18] for function of moving an image file from one folder to another folder;

also see [column 7, lines 35-65]).

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

12.   Claim 2 (effective filing date 10/09/2002) are rejected under 35 U.S.C. 103(a) as being

unpatentable over <u>Takemoto</u> (US Patent No 6,335,742 , effective filing date July 24,1998), and

further in view of <u>Forster</u> (Publication No US 2003/0167287, effective filing date 04/11/2001).

        As to claim 2, <u>Takemoto</u> teaches all the limitations as recited in claim 1.

        However, <u>Takemoto</u> does not explicitly teach "inhibiting means for inhibiting the

movement of the image data from which the link is canceled if the same image data as the image

data to be moved is already stored in the second storage area".

        <u>Forster</u> teaches "inhibiting means for inhibiting the movement of the image data from

which the link is canceled if the same image data as the image data to be moved is already stored

in the second folder" (see <u>Forster</u>, [0041] wherein modified file is not copied into the file

collection when modified file is identical to existing file in the file collection represents an

inhibiting means).

        It would have been obvious to a person having ordinary skill in the art at the time the

invention was made to incorporate the teaching of <u>Takemoto</u>'s system to include an inhibiting

means for inhibiting the movement of the image from which the link is canceled if the same

image data as the image data to be moved is already stored in the second storage area. Skilled

artisan would have been motivated to do so in order to reduce time and resource cost involved in

the moving process and the system therefore proceeds more efficiently and effectively.

13.   Claim 3 (effective filing date 10/09/2002) are rejected under 35 U.S.C. 103(a) as being

unpatentable over Takemoto (US Patent No 6,335,742 , effective filing date July 24,1998), and

further in view of Miller et al. (Publication No US 2003/0018777)

    As to claim 3, Takemoto teaches all the limitations as recited in claim 1.

    However, Takemoto do not teach "wherein when canceling the link information, the link

release means rewrites header information of the audio data and rewrite header information of

the image data to cancel the link between the audio data and the image data".

    On the other hand, Miller et al. teaches "wherein when canceling the link information, the

link release means rewrites header information of the audio data and rewrite header information

of the image data to cancel the link between the audio data and the image data" (see Miller et al.,

[0075] and [0089] for including link information in file header).

        It would be obvious to a person having an ordinary skill in the art at the time the

invention was made to incorporate the teaching of Takemoto's system to store link data within

the audio data and image data, especially in their file header. Skilled artisan would have been

motivated to do so to provide an effective and convenient way to manage and control the link

information.

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Phuong-Thao Cao whose telephone number is (571)272-2735.
The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
may be obtained from either Private PAIR or Public PAIR. Status information for unpublished
applications is available through Private PAIR only. For more information about the PAIR
system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would
like assistance from a USPTO Customer Service Representative or access to the automated
information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung T Vy/
Primary Examiner, Art Unit 2163

Phuong-Thao Cao
Art Unit 2164
August 22, 2008